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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,845	10/23/2001	Shlomo Ben-Haim	IMP031-228740	1690
54942 7590 09/12/2008 WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP 250 PARK AVENUE 10TH FLOOR NEW YORK, NY 10177				
EXAMINER OROPEZA, FRANCES P				
ART UNIT		PAPER NUMBER		
3766				
NOTIFICATION DATE		DELIVERY MODE		
09/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO@WOLFBLOCK.COM

### Office Action Summary

**Application No.**

10/039,845

**Applicant(s)**

BEN-HAIM ET AL.

**Examiner**

FRANCES P. OROPEZA

**Art Unit**

3766

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/17/08 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgement***

1. Mr. Carl Layno was the Examiner originally assigned to this case. Mr. Layno was promoted to a Supervisory position in the U.S. Patent and Trademark Office. Since this case was in mid-prosecution at the time of Mr. Layno's promotion, it has been assigned to a new Examiner. The current Examiner acknowledges the Applicant's response of 1/17/08 where the sole independent claim, claim 5, was amended, hence the rejection of record is withdrawn and a new rejection established in the subsequent paragraphs.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Zipes (U.S. Patent No. 4,384,585). Zipes discloses a heart control apparatus generating non-excitatory stimulus in the area of the heart involved in the genesis and maintenance of tachyarrhythmias, where the first stimulation has a first effect on the first area of the heart and the second stimulation has a second effect on the second area of the heart, such that the relationship between the areas stimulated modifies the relationship between the contractions in these two areas of the heart. The areas of the heart treated can be the atria or ventricles. When the ventricles are determined to

originate and maintain the tachyarrhythmia, the ventricles are simultaneously controlled and stimulated for a few beats every certain period of time, to increase the flow from one ventricle and decrease the flow from the other ventricle (abstract; column 1, lines 31-34; column 1, line 55 – column 2, line 3; column 3, lines 12-18, 38-43; column 4, lines 6-11; column 4, line 37 – column 5, line 4).

Note the concept of non-excitatory stimulation amounts to an intended use limitation of which Zipes inherently performs or is capable of performing.

4. Claims 5, 10, 11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Prystowsky et al. (U.S. Patent No. 4,554,922). Prystowsky et al. disclose a heart control apparatus generating non-excitatory stimulus in heart tissue during the refractory period of the cardiac cycle, where the first stimulation has a first effect on the first area of the heart and the second stimulation has a second effect on the second area of the heart, such that the relationship between the contractions in these two areas of the heart is modified. For example, when the right ventricular contraction is modified, this changed results in a modification of the relationship to the left ventricle. Single or multiple areas of the heart can be simultaneously stimulated for a few beats every certain period of time (abstract; column 1, lines 28-36; column 54 – column 2, lines 11).

Note the concept of non-excitatory stimulation amounts to an intended use limitation of which Prystowsky et al. inherently performs or is capable of performing.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prystowsky et al. (U.S. Patent No. 4,554,922) in view of Zipes (U.S. Patent No. 4,384,585).

As discussed in paragraph 4 of this action, Prystowsky et al. disclose the claimed invention except for the heart control apparatus controlling both ventricles.

Zipes teaches synchronized cardioverting using a lead configuration that delivers a electrical stimulation to both ventricles of the heart for the purpose of treating the point of origin and maintenance of tachycardia. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a lead configuration that delivers a charge to both ventricles of the heart in the Prystowsky et al. in order to use a proven treatment that includes

both ventricular areas in the heart, so a more comprehensive treatment can be applied to the cardiac tissue of the patient, so the tachycardia can be successfully treated, and the development of fibrillation can be avoided (column 1, lines 31-34, 61-66; column 3, lines 12-18, 24-31; column 4, lines 6-11).

### *Conclusion*

**7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM-11PM EST. The fax phone numbers for the organization where this

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application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/  
Patent Examiner, Art Unit 3766

/Carl H. Layno/  
Supervisory Patent Examiner, Art Unit 3766